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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,085	03/24/2004	John Ratzloff	1449.001US2	5362
21186	7590	02/09/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			GHATT, DAVE A	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/808,085	RATZLOFF, JOHN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dave A. Ghatt	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3 and 7-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216). Hunter et al. in view of Policht teaches the claimed method. With respect to claims 3, 10, and 11, Hunter et al. teaches a method of preserving a printed image. As illustrated in Figure 5, Hunter teaches the step of providing a blank photo-grade sheet 110, and attaching a hinge strip 114 mounted along an edge of the printer paper sheet. (See also column 7 lines 9-15.) Figure 5 shows, and column 6 line 67 of Hunter et al. teaches the hinge strip including a flexible portion 126 for allowing the hinge strip to bend. Figure 5 also teaches the step of providing a mounting portion 122 for mounting the page to a binder. (See column 1.) Figure 11 teaches the step of printing an image on the photo-grade sheet by sending the photo-grade sheet through a desktop printer. As stated above, Hunter et al. teaches all the claimed steps for preserving photo-grade sheets, except Hunter et al. does not specifically teach mounting photo-grade sheet to an album. Policht teaches a similar process as Hunter, which as illustrated in Figures 5-7, includes mounting photo-grade paper to an album. To one of ordinary skill in the art, it would have been obvious to use the process of Hunter et al., for preserving photo-grade paper as taught by Policht, in order to provide an improved photo

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package that mounts all photo-grade paper, uniquely within a book-like cover, as taught by Policht in column 1 lines 38-45.

With respect to the requirement for *photo-grade paper*, the applicant should note that insofar as structure is defined, the printer paper sheet 110 of Hunter meets this limitation, as a photo of good quality may be printed on the sheet. Furthermore the *photo-grade paper* as broadly recited, does not define a cut-off requirement as to what quality of photo is enough to meet this limitation. The secondary reference Policht shows the obviousness of mounting the photo-grade paper to an album.

With respect to claim 7, Figure 11 of the primary reference Hunter et al. shows the step of sending the blank sheet and attached mounting strip through the printer to print an image on the sheet, such that the image becomes integral with the paper.

With respect to claim 8, Figure 11 of the primary reference Hunter et al. shows the step of sending the blank sheet and attached mounting strip through a desktop digital printer. Column 5 lines 61-66 teach the use of a digital printer.

With respect to claims 9 and 12, the primary reference Hunter et al. teaches mounting holes 122.

With respect to claim 11 the primary reference teaches mounting holes 122, as taught in column 6 lines 63-64 for mounting to a binder. As outlined above, Hunter et al. does not specifically teach mounting photographic printing paper to an album. Policht teaches a similar process as Hunter, which as illustrated in Figures 5-7, includes mounting photo-grade paper to an album. To one of ordinary skill in the art, it would have been obvious to use the process of Hunter et al., for preserving photo-grade paper as taught by Policht, in order to provide an

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improved photo package that mounts all photo-grade paper, uniquely within a book-like cover, as taught by Policht in column 1 lines 38-45.

3. Claims 4, 6, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216) as applied to claims 3 and 7-12 above, and further in view of Tyler (US 4,207,366). As outlined above, Hunter et al. and Policht teach all the claimed method steps, except the composition of the photo-grade sheet is not known. With respect to claims 4, 6, and 13, column 1 lines 35-54 of Tyler teach paper for printing, the paper comprising 100% cotton rag paper. Column 1 lines 35-54 also teach the use of neutral (acid-free) paper. To one of ordinary skill in the art, it would have been obvious to use the paper taught by Tyler, in the method of Hunter et al. and Policht, in order to provide dimensionally stable crush resistant paper, as taught in the abstract of Tyler.

With respect to claim 14, and the requirement for an acid free hinge strip, column 1 lines 48-54 teach the importance of neutral (acid-free) paper. In view of this teaching of Tyler, it would have been obvious to one of ordinary skill in the art to make an acid-free hinge strip because neutrality in paper is the most important factor in paper permanence as taught by Tyler in column 1 line 50.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Policht (US 5,040,216) as applied to claims 3 and 7-12 above, and further in view of Singh et al. (US 6,332,953). ). As outlined above, Hunter et al. and Policht teach all the claimed method steps, except the composition of the paper is not known. Column 2 lines 48-

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50 of Singh teach paper for printing, the paper being unbleached and uncoated. To one of ordinary skill in the art, it would have been obvious to use the unbleached and uncoated paper of Singh et al., in the method of Hunter et al. and Policht, because paper of this composition has been routinely used for printing purposes, as taught in column 2 of Singh et al.

### ***Response to Arguments***

5. Applicant's arguments and affidavit filed Nov 21, 2005 have been fully considered but they are not persuasive. As outlined in the rejection statement, with respect to the requirement for *photo-grade paper*, the applicant should note that insofar as structure is defined, the printer paper sheet 110 of Hunter meets this limitation, as a photo of good quality may be printed on the sheet. Furthermore the *photo-grade paper* as broadly recited, does not define a cut-off point as to what quality of photo is enough to meet this limitation.

With respect to the affidavit, the declarant makes statements of conclusion without providing reasons for his conclusions. For example, the declarant states that the paper disclosed in Hunter, "would not meet customer expectations for a grade labeled as photo quality." However the declarant does not state how he comes to this conclusion.

Generally speaking, the affidavit fails to outline what the qualities that make paper photo-grade. It is the Office's position that paper substrates can possess various levels of photo-grade quality. In other words, within a range of acceptable photo-grade images, some paper substrates may facilitate better or clearer photos. The Office contends that the paper according to Hunter produces images that are within the acceptable range. The affidavit does not outline the

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characteristics of the Hunter paper that disqualifies it from being defined as 'photo-grade'.

Consequently, the affidavit is rendered non-persuasive, and the rejection stands.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave A. Ghatt whose telephone number is (571) 272-2165. The examiner can normally be reached on Mondays through Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAG



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